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on this date:
March 25, 2005
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PETITION FOR WITHDRAWAL OF ELECTION REQUIREMENT

Mail Stop Petition
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In response to the election of species requirement made final in the Office action dated December 2, 2004, the applicant hereby petitions the commissioner for reconsideration and reversal of the election requirement. Applicant traversed and requested reconsideration of the improper election requirement in the response mailed October 20, 2004. Therefore, the right to file this petition has been properly preserved.

By the way of background, the Office action mailed on September 24, 2004 included an election of species requirement. The Office action identified

the application as containing two (2) patentably distinct species of the claimed invention. Specifically, the Office action required an election of species between figure 4 (Species 1) and figure 6 (Species 2). The applicant responded by demonstrating that the Office action failed to meet the procedural requirements for issuing an election of species and that the election of species requirement was substantively in error.

In the Office action mailed December 2, 2004, the Examiner agreed that the arguments raised by the applicant were correct “for restriction, but [the Examiner argued that] the initial action requires an elections of species, which is different from restriction.” Thus, the Examiner argued that he did not have to meet requirements for restriction laid out in the MPEP.

However, MPEP § 802.02 states:

Restriction, a generic term, includes the practice of requiring an election between distinct inventions, for example, election between combination and subcombination inventions, and the practice relating to an election between independent inventions.

Thus, the requirements laid out in the MPEP for “Restrictions” are applicable to restrictions between independent inventions (sometimes colloquially referred to as “restriction requirements”) and restrictions between inventions that are not independent but are, nonetheless, distinct (i.e., election of species requirements). Accordingly, the Examiner’s position that he can ignore the MPEP requirements for “restrictions” in presenting an election of species requirement is in error and has created the necessity for this petition and reversal. Throughout the remainder of this petition the generic term

“restriction requirement” is used in keeping with the MPEP to encompass the election of species requirement at issue.

The arguments raised in the Response mailed October 20, 2004 will now be re-presented for consideration by the Commissioner.

Turning first to the procedural issues, the Office action did not meet the procedural burdens required to issue a proper restriction requirement. The M.P.E.P. clearly and unequivocally states that there are two criteria which *must* be met for a requirement for restriction to be proper: (1) the inventions must be independent or distinct as claimed; and, (2) there must be a serious burden on the examiner if restriction is not required. (M.P.E.P. § 803)¹. As explained below, the Office action failed to meet either of these two required criteria. Accordingly, the restriction requirement is procedurally improper and must be overturned.

M.P.E.P. § 808 sets forth an examiner’s burden under the first required criteria of making a restriction requirement. Specifically, M.P.E.P. § 808 states: “[e]very requirement to restrict has two aspects: (A) the reasons (as distinguished from the mere statement of conclusion) why the inventions *as claimed* are either independent or distinct; and (B) the reasons for insisting upon the restriction therebetween....” MPEP § 816 expounds upon this requirement:

The particular reasons relied upon by the examiner for holding that the inventions as claimed are either independent or distinct should

¹ As explained above, these requirements apply to election of species requirements because election of species requirements are, in fact, requirements for restriction.

be concisely stated. *A mere statement of conclusion is inadequate.* The reasons upon which the conclusion is based should be given.

(emphasis added).

The Office action did not meet this requirement. Instead, the Office action conclusorily stated that “this application contains claims directed to the following patentably distinct species of the claimed invention: species 1, figure 4; species 2, figure 6.” Clearly, the Office action’s statement is “a mere statement of conclusion” which MPEP § 816 unmistakably declares to be inadequate for meeting the Examiner’s burdens under M.P.E.P. § 808. Accordingly, the restriction requirement failed to meet the criteria of M.P.E.P. § 808, and, thus, fails to meet the first criteria of MPEP § 803, because it failed to provide any reasoning whatsoever as to why the inventions are distinct or independent. Therefore, on this basis alone, the requirement for election must be overturned.

The second requirement that a restriction requirement must meet under MPEP § 803, is a showing that a serious burden will be placed on the examiner if restriction is not required. “For purposes of the initial requirement, a serious burden on the examiner may be prima facie shown if the examiner shows by appropriate explanation of separate classification, or separate status in the art, or a different field of search as defined in MPEP § 808.02.” (M.P.E.P. § 803).

In the instance on petition, although the Office action identified figures that the examiner believed to reflect patentably distinct species, it failed to show that the alleged species are separately classified, have a separate status in

the art, or require different fields of search. Indeed, the Office action made absolutely no effort to show a serious burden would be placed on the Examiner if restriction were not required. Thus, it is clear that the Office action also failed to address the second required criteria for restriction set forth in M.P.E.P § 803. In view of the following mandate, this failure to address the second required criteria for issuing a restriction requirement is particularly egregious:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

(M.P.E.P. § 803)(emphasis added). All of the claims of this application can be examined together without serious burden on the examiner. Therefore, the Office must examine it on the merits irrespective of whether it includes claims to distinct or independent inventions.

From the foregoing, it is plainly evident that the Office action failed to meet the procedural criteria for issuing a restriction requirement. In particular, the Office action failed to provide even a shred of evidence that (1) the inventions are independent or distinct as claimed; or, (2) that there would be a serious burden on the examiner if restriction were not required. Failure to meet either of these criteria renders a restriction requirement improper. Failure to meet both of these criteria renders a restriction requirement unconscionable. Accordingly, the applicant respectfully submits that the requirement for restriction must be overturned.

As demonstrated above, the Office action failed to meet its procedural burdens for requiring restriction. Accordingly, as a procedural matter, the restriction requirement must be overturned. Moving beyond the procedural failures, to the substance of the restriction requirement, it is readily apparent that there is still another reason that the restriction requirement must be withdrawn. The MPEP unequivocally states, "Claims to be restricted to different species must be mutually exclusive." MPEP § 806.04(f). The MPEP goes on to expound on this point by explaining: "The general test as to when claims are restricted ... to different species is the fact that one claim recites limitations which under the disclosure are found in a first species but not in a second, while a second claim recites limitations disclosed only for the second species and not for the first." *Id.* In the application at issue, while independent claims 2 and 5 are directed toward limitations found only in the second alleged species (i.e., figure 6), independent claims 1 and 4 do not recite any limitations that are not present in both alleged species (i.e., in figures 4 and 6). Accordingly, it is clear that independent claims 1, 2, 4 and 5 are not mutually exclusive under the MPEP's general test quoted above. Accordingly, it is clear that those claims must be examined together.

In view of the foregoing, it is clear that the election of species requirement is procedurally and substantively in error. Accordingly, it is respectfully requested that the election of species requirement be overturned and the examination of all of the claims of this application be conducted together.

The Commissioner is hereby authorized to charge any fees which may be required for this petition to Deposit Account No. 50-2455. A copy of this paper is enclosed.

Respectfully submitted,

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By:



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